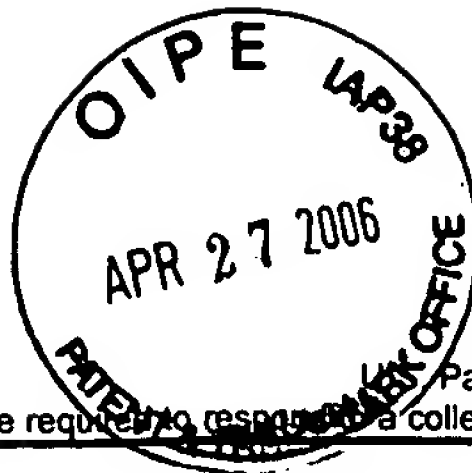


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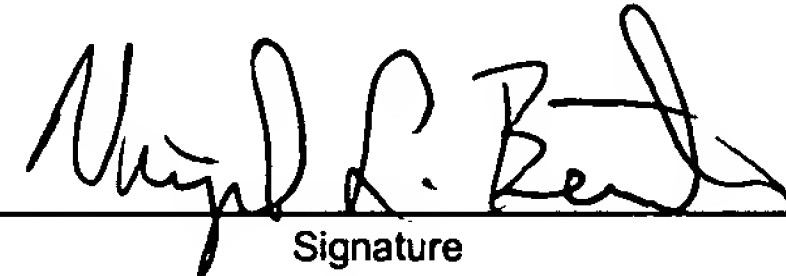
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		1778.0200000	(MIPS 0128.00US)
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number	Filed	
	09/836,541	April 18, 2001	
	First Named Inventor		
	Ryan C. Kinter		
	Art Unit	Examiner	
	2183	Pan, Daniel H.	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 47,415</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			



Signature

Virgil L. Beaston

Typed or printed name

(202) 371-2600

Telephone number

4/27/06

Date

☒ \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Kinter *et al.*

Appl. No.: 09/836,541

Filed: April 18, 2001

For: **Mapping System And Method For  
Instruction Set Processing**

Confirmation No.: 6813

Art Unit: 2183

Examiner: D. Pan

Atty. Docket: 1778.0200000

### **Arguments to Accompany the Pre-Appeal Brief Request for Review**

***Mail Stop AF***

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit the following Arguments, in five (5) or less total pages, as an attachment to the Pre-Appeal Brief Request for Review (Form PTO/SB/33). A Notice of Appeal is concurrently filed.

### ***Status Of Claims***

Claims 1-3, 5-6, 8, and 10-20 are pending in the application, with 1, 5, 8, 10, and 15 being the independent claims.

In the latest Office Action, mailed on November 28, 2005, claims 1-3, 5-6, 8, and 10-14 were indicated as being allowed, claim 16 was objected to, and claims 15 and 17-20 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

In response to the November 28, 2005 Office Action, Applicants filed a Reply on February 28, 2006. In this Reply, Applicants amended claims 15-20. On March 15, 2006, Applicants received an Advisory Action indicating that for purposes of an appeal, the amendments to the claims would be entered, claims 1-3, 5-6, 8, and 10-14 would be identified as

allowed (with suggestions), and claims 15-20 would be rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

### ***Summary Of 35 U.S.C. § 101 Issues***

In a telephone conversation with Examiner Daniel Pan on April 25, 2006, following the mailing of the March 15, 2006 Advisory action, Applicants' representative was informed that for purposes of an appeal, all of the pending claims (including those previously allowed) would be rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. According to Examiner Pan, the basis for rejecting all of the pending claims under 35 U.S.C. § 101 relates to paragraph [0054] of the Applicants' application. Paragraph [0054] discloses, in part, that certain software related embodiments of the claimed invention can be distributed over a network. *See* lines 12-15 of paragraph [0054]. According to Examiner Pan, new PTO examination guidelines require Examiners to reject computer related claims under 35 U.S.C. § 101 whenever the specification of an application discloses language similar to that contained in paragraph [0054] of applicants' specification.

### ***Arguments***

Claims 1-3 are directed to a cache controller for use with a processor, claims 5 and 6 are directed to a method for mapping an instruction set in a cache controller, and claim 8 is directed to a processor. Each of these claims relates to subject matter (e.g., a computer) which is statutory under 35 U.S.C. § 101. Thus, any rejection of claims 1-3, 5-6, and 8 under 35 U.S.C. § 101 is improper.

Claims 10-14 are directed to a tangible computer readable medium comprising a microprocessor core embodied in software. In 1995, the Commissioner of Patents and Trademarks conceded to the U.S. Court of Appeals for the Federal Circuit "that computer

programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101.” See In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995). Thus, any rejection of claims 10-14 under 35 U.S.C. § 101 is improper.

Claims 15-20 are directed to a method for distributing computer readable program code that embodies a microprocessor core according to the claimed invention over a network such as, for example, the Internet. The Internet has become a common means for businesses to distribute computer readable program code to customers, and in many instances, the Internet is replacing more traditional distribution means such as floppy diskettes. There is no requirement for method claims to be tangible, and it is believed that the act of distributing computer readable program code over the Internet does not render otherwise patentable subject matter unpatentable, especially in light of the U.S. Court of Appeals for the Federal Circuit holdings in cases such as State Street Bank & Trust v. Signature Financial Group, Inc., 149 F.3d 1368 (Fed. Cir.), *cert. denied* 119 S. Ct. 336 (1998) (holding that the question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter -- but rather on the essential characteristics of the subject matter, in particular, its practical utility), and AT&T Corp. v. Excel Communications, Inc., 173 F.3d 1352 (Fed. Cir. 1999) (holding that computer-based programming constitutes patentable subject matter and is patentable under 35 U.S.C. § 101 if the invention, as a whole, produces a tangible, useful, result). Thus, it is believed that the rejection of claims 15-20 is improper.

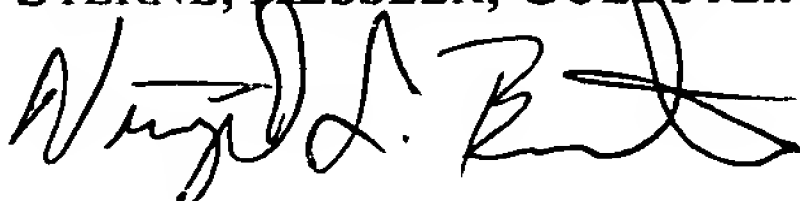
***Conclusion***

Applicants respectfully submit that claims 1-3, 5-6, 8, and 10-20 are directed to statutory subject matter and, as such, the present application is in condition for allowance. Prompt and favorable consideration of Applicants' Pre-Appeal Brief Request for Review is respectfully requested.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Virgil L. Beaston  
Attorney for Applicants  
Registration No. 47,415

Date: April 28, 2006

1100 New York Avenue, N.W.  
Washington, D.C. 20005-3934  
(202) 371-2600